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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,667	04/07/2000	David R. Thomas	TI-27109	9856

23494            7590            09/23/2004

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EXAMINER

CUFF, MICHAEL A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	M
	09/545,667	THOMAS ET AL.	
	Examiner	Art Unit	
	Michael Cuff	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 August 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,35,37-39,41-46 and 49-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,35,37-39,41-46 and 49-76 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 35, 37-39, 41-46 and 49-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan in view of Shah-Nazaroff et al.

Kaplan shows all of the limitations of the claims except for specifying the degraded signal for the samples and some details as to how the digital signal is processed.

Kaplan shows, figure 2, a network and method for preview and sale (includes authorization requests and replies) of music products. Kiosk unit 10 acts as a dialogue unit, digital processor, with a product reader including a signal-processing unit. Ranges of audio/video products are available. Database 60 maintains customer files and demand data.

Shah-Nazaroff et al. teaches, figure 5, a system and method for purchasing upgraded media features for programming transmissions. Figure 5 teaches the building of a client history which records the level of quality of a signal based on the price the client wishes to spend in order to increase profits by providing alternative quality products.

Based on the teaching of Shah-Nazaroff et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Kaplan system to select a defined quality level (degraded level) in order to increase profits by providing alternative quality products.

The examiner takes official notice the digital signal processes claimed are old and well known and are commonly used in order to manipulate digital products. This is admitted prior art based on previous prosecution history.

Based on the discussion above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Kaplan system to use standard digital processes in order to manipulate digital products.

### ***Response to Arguments***

Applicant's arguments filed 8/12/04 have been fully considered but they are not persuasive.

Applicant asserts that claims 49-76 recite new issues. The examiner does not concur. The mere re-working of claim language, which was rejected based upon admitted prior art does not present new issues.

Applicant asserts that the broad term "client history" requires a record of prior dealings between the client and the merchant server. The examiner does not concur. Applicant is reading limitations into the claim language, which do not exist. If applicant wants this limitation examined as part of the application, applicant is welcome to amend the claims to recite --said client history is based on a record of prior dealings between the client and the merchant server--.

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Applicant asserts that the prior art does not show defining a level of content degradation dependent upon a client history. The examiner does not concur. Since the examiner is considering the order form as part of the "client history", the level is dependent. For the record, "history", per Webster's Ninth New Collegiate Dictionary, can be defined as a chronological record of significant events or a tale or a story.

Applicant asserts that the combination of Kaplan and Shah-Nazaroff et al. does not show transmitting a degraded evaluation version of the selected product without payment authorization. The examiner does not concur. Kaplan shows the ability to transmit previews and Shah-Nazaroff shows the ability to upgrade quality. The examiner believes that it is an inherent feature that the Kaplan kiosk has the capability to, and would most likely because of cost would, use the lowest quality version during the preview. The following patents are cited as evidence that previews are accomplished with lower quality. (6,005,621 column 10, lines 13-31; 6,157,929 column 18, lines 48-63; and 6,314,208 column 1, lines 53-62)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (703) 308-0610. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Cuff  
September 16, 2004